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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,014	02/28/2002	Andrea Hughs-Baird	0112300-610	3796

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EXAMINER	
MOSSER, ROBERT E	
ART UNIT	**PAPER NUMBER**
3713	

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/086,014	HUGHS-BAIRD ET AL.	
	Examiner	Art Unit	
	Robert Mosser	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10-12-2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18,20 and 21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11,15,18,20 and 21* is/are rejected.

7)☐ Claim(s) *12-14,16 and 17* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

♦

This action is Final.

Claims 1-18 and 20-21 are pending.

♦

Terminal Disclaimer

The terminal Disclaimer filed in this application on October 12th, 2005 was approved hence the previous presented rejections under double patenting and USC 103 have been withdrawn.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 12th, 2005 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **1-11, 15, 18, 20** and **21** are rejected under 35 U.S.C. 102(e) as being anticipated by Baerlocher et al (US 6,648,754)

[The content of section below entitled, Response to Arguments is incorporated herein]

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding at least claim **1**, Baerlocher et al teaches a gaming device having a game comprising:

A plurality of values (equivalently offers) greater then zero (See grid figure 4b);

A plurality of player selectable masked selections (Elements 108a-108x);

A display device (Figure 1, Elements 30, 32); and

A processor adapted to communicate with the display device (Figure 2), said processor and said display device adapted to:

(a) associate said values with said selections (Col 6:47-51);

(b) enable a player to select one of said selections (Col 6:47-51);

(c) reveal the value associated with the selected selection to the player (Col 6:47-51);

(d) enable the player to accept or reject the revealed value (Col 6:52-63); and

(e) repeat steps (a) through (d) at least once if said player rejects said revealed value, wherein if the player rejects said revealed values, said revealed value is re-associated with one of said masked selections for at least one subsequent selection (Col 10:30-44).

Regarding claims **2-3**, the plurality of values are randomly selected and associated with game selections (Col 7:40-61) from a pool of offers wherein the "pool" of offers includes all tangible game offers.

Regarding claims **4, 7** and **9**, Baerlocher shows in the grid of figure 4b a number of offers equal to the number of selections. Wherein a step number is associated with each possible selection shown and the instant language "number of offers" is met by the multiple presentation of a single value (Figure 23, Element 108. "23"). Additional claim language in claim 9 stating, "each said offer" is not equivalent to "each unique offer" and hence fails to separate from the prior art of Baerlocher.

Regarding claim **5**, Baerlocher may be considered alternatively to teach the inclusion of a number of values greater then the number of selections in the realization of "the present invention includes not associating or placing one or more possible steps" (Col 7:45-50).

Regarding claims **6** and **10,** Baerlocher may be considered alternatively to teach the inclusion of a number of values less then the number of selections. Wherein a step number is associated with each possible selection shown in figure 4b contains the use of repeated specific values such as the number 23 (Col 7:40-60). Hence as understood this can be interpreted as a number of unique values less then the number of selections.

Regarding claim **8,** Baerlocher teaches the re-association (reshuffling) of values with selection after the user rejects one selection (Col 10:29-44).

Regarding at least claim **11** and in addition to the above, Baerlocher et al teaches a gaming device having a game comprising:

A plurality of values greater then zero (See grid figure 4b);

A plurality of player selectable selections (Elements 108a-108x);

A display device (Figure 1, Elements 30, 32); and

A processor which communicates with the display device (Figure 2), associates said vales with said selections wherein each selection is associated with one of said value (Figure 4), displays to a player the association between at least one of the values associated with one of the selections and said selection (Figure 5D), causes the display device to display a rearrangement (reshuffling) of the selectable selections wherein after the rearrangement of the selectable selections on the display each selection remains associated with said previously associated value, enables the player to select one of the

selections, and provides the player the value associated with the selection (Col 10:36-44).

Regarding claim **15**, Baerlocher et al teaches the random determination of the value associated with said selections prior to enabling their selection by the player (See Element 108 in figures 4b & 5c).

Regarding claims **18** and **21**, Baerlocher et al teaches a method for operating a gaming device including the triggering a gaming device (Col 4:15-29), associating a plurality of non-zero values with a plurality of selections (Col 7:40-46), displaying said plurality of selections (Figure 4), revealing the value associated with one of the selections picked by the player(Figure 5b), allowing the player to accept or reject the value, providing the value to the player if the player accepts the value or the selection is the last selection, and when the player selection is not their last selection/pick repeating the above if the player rejects the value including re-associating the rejected value into one of the possible selections for a subsequent selection (Col 10:36-44). Baerlocher further allows for the "reshuffling" of the steps and their associated order (Col 10:36-44) , which in turn is understood as the claimed rearrangement of the selections wherein each selection remains associated with said previously associated value.

Regarding claim **20**, the apparatus/method of Baerlocher teaches revealing a singular value associated with each selection and hence this singular value must represent the maximum and minimum offer (Figure 4).

Response to Arguments

Applicant's arguments filed October 12th, 2005 have been fully considered but they are not persuasive.

In the interpretation of the newly amended claims it is noted that the applicant has replaced the word "value" with the word "offer" in some claims while retaining the use of the word "value" in other claims. As these terms have been presented interchangeable without any setting forth definition or support for a separate interpretation of these two terms they have been deemed equivalent for the purposes of this action.

Starting on page eight of response directed to the rejection claim 1, the applicants submit "...Baerlocher reveals a number of steps associated with the player picked selection, wherein the offer the player may accept or reject is based on the accumulated number of steps. On the other hand, in the gaming device of amended independent Claim 1, the offer which the player may accept or reject is directly associated with the player picked selection".

This argument fails on the following points.

I) The applicant is arguing features and limitations of narrower scope then presented by the pending claims.

II) As presently argued the applicant appears to be equating the claimed value(s) or offer(s) is a prize amount awarded to a player, this feature however is not reflected in the pending claims.

Starting on page eight of response directed to the rejection claim 11, the applicants submit, "...Baerlocher teaches a gaming device which "causes a display device to display a rearrangement (reshuffling) of the selectable selections wherein after the rearrangement of the selectable selections on the display each selection remains associated with said previously associated value". This is incorrect. Baerlocher states that "[t]he game alternatively reshuffles or redistributes the numbers of steps associated with the selections 108a through 108x after each offer and thereby provides a new order of steps associated with the selections 108a through 108x." Redistributing the numbers of steps associated with the selections after each offer is different than displaying to the player the association between at least one of the values associated with one of the selections and the selection and then displaying a rearrangement of the selectable selections".

On a first point it is unclear where or how the described process of Baerlocher from the prior office action is "incorrect" given the quotation from Baerlocher provided by applicant. And while the correlation of the previous office action was not verbatim to that of Baerlocher such is often necessary in order to better communicate the correlation of prior art to the applicant's claimed invention.

On a second point the applicant's proposition that the process of the prior art and the claimed invention differ, the applicant has been vague in pointing out where they believe the distinction lies between the prior art and the present invention given the following,

i) "Redistributing the numbers of steps associated with the selections after each offer" [Baerlocher]

ii) "displaying to the player the association between at least one of the values associated with one of the selections and the selection and then displaying a rearrangement of the selectable selections" [Applicant]

If the applicant is referring to the lack of a corresponding "displaying to the player the association between at least one of the values associated with one of the selections and the selection", as presented in their arguments, this feature has been provided for by the prior office action in the line preceding the applicant's quotation and further including reference to Figure 5D of Baerlocher for the teaching of this feature. In addition a secondary reference within Baerlocher maybe found for this feature through corresponding feature in claim one as presented in the last office action.

Remainder arguments directed to claims **2-10, 15, 18, 20** and **21** are reliant on the above addressed issues and fall for their dependency thereon.

Allowable Subject Matter

Claims **12-14** and **16-17** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued

examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571)272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

REM

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SUPERVISORY PATENT EXAMINER
TC3700